



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

COPY MAILED

OCT 19 2006

OFFICE OF PETITIONS

In re Application of :
Darin Higgins, Dan Scott and : DECISION ON PETITION
John Howard :
Application No. 09/820,552 :
Filed: March 29, 2001 :
Atty Docket No. 108344.00013 :

This is a decision on the REQUEST FOR GRANT OF PETITION TO
CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.48(a) AND PETITION TO
FILE DECLARATION UNDER 37 C.F.R. 1.183 filed June 19, 2006.

(The petition includes persuasive evidence that this petition
was originally filed December 19, 2005).

The petition is **GRANTED**.

The above-identified application was filed on March 29, 2000,
with a declaration executed by joint inventors Darin Higgins and
Dan Scott. On December 19, 2005 (and resubmitted on June 19,
2006), the instant request under § 1.48(a) was filed to amend
the inventorship to add joint inventor John Howard.

37 CFR 1.48(a) requires:

(1) A request to correct the inventorship that sets forth
the desired inventorship change;

(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;

(4) The processing fee set forth in § 1.17(i); and

(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

Petitioner has satisfied requirements (1), (2), (4) and (5) above. The petition specifically requests the addition of inventor Howard. The petition includes a statement from inventor Howard that the inventorship error occurred without deceptive intent. Petitioner has paid the processing fee. The petition includes a statement signed by Robert Kennard, with a statement that he is authorized to sign on behalf of the assignee company, consenting to the change in inventorship. Petitioner states that the assignment reflecting this ownership is recorded at reel/frame 013910/0173.

However, the petition does not satisfy requirement (3) above. The declaration submitted is re-executed by inventor Scott and executed by inventor Howard. Petitioner requests waiver of the requirement that all of the inventors sign the declaration on the basis that non-signing inventor Higgins refuses to join in the application and/or cannot be found or reached after diligent effort to join in the application.

On very infrequent occasions, the requirements of 37 CFR 1.48(a) have been waived upon the filing of a request and fee under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). As 37 CFR 1.48(a) is intended as a simple procedural remedy and does not represent a substantive determination as to inventorship, issues relating to the

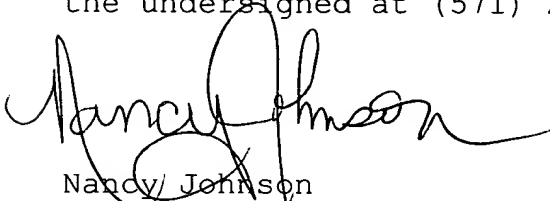
inventors' or alleged inventors' actual contributions to conception and reduction to practice are not appropriate for consideration in determining whether the record unequivocally supports the correction sought.

As to requirement (3), in such circumstances, a petition under 37 CFR 1.183 should be considered requesting waiver of the requirement of 37 CFR 1.64 that each of the actual inventors execute the oath or declaration, particularly where assignee consent is given to the requested correction. Absent assignee consent, the petition under 37 CFR 1.183 requesting waiver of the re-execution of the oath or declaration will be evaluated as to whether the non-signing inventor was actually given the opportunity to re-execute the oath or declaration, or whether the non-signing inventor could not be reached. See MPEP 201.03. As discussed above, assignee consent is given to the requested correction. This consent is supplemented by evidence that non-signing inventor Higgins has refused to join in the application. Accordingly, the waiver is GRANTED.

Receipt of payment of the processing fee of \$130 under 1.17(i) is acknowledged. The petition fee of \$400 (not \$130) under 37 CFR 1.183 has been charged to petitioner's Deposit Account, as authorized.

The instant application is under a notice of allowance. The Office of Patent Publication has been advised of this decision.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized, flowing script.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions